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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,805

08/25/2006

Ulrich Kautz

27599U

2179

34375 7590 03/24/2010

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EXAMINER

DESAI, RITA J

ART UNIT

PAPER NUMBER

1625

MAIL DATE

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03/24/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,805	<b>Applicant(s)</b> KAUTZ, ULRICH	
	<b>Examiner</b> Rita J. Desai	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/20/10</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Applicants have cancelled claims 1-17 and added new claims 18-25 drawn to specific species and their pharmaceutical compositions.

Response to the arguments :-

The rejection under 35 USC 112 has been withdrawn as applicants have cancelled the Markush groups and now the claims are only directed to specific species.

The new claims have the formula and specific species. This raises some objection which are given below after the response.

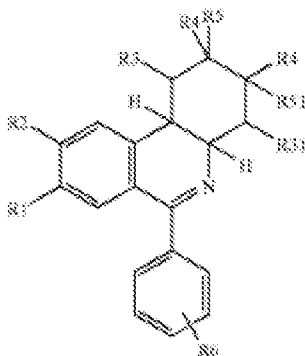
The rejection under 35 USC 103 over WO 99/05111, WO, 02/05616, WO 2004/019945 and WO 2005/077906 on claims 1-17 has been withdrawn as these claims are cancelled however the new claims 18-25 are now rejected under USC 103 over WO 99/05111, WO, 02/05616, WO 2004/019945 and WO 2005/077906 and US 6538005. The applicants arguments are not found to be persuasive and the reasons are given here.

Applicants argue that claims 1-17 have been cancelled and that the new claims are 18-25 which are species which are not obvious over the cited references.

Applicants argue that WO 99/05111, WO, 02/05616, WO 2004/019945 do not teach the specific het group on the phenyl and WO 2005/077906 has a 102(e) date and is commonly owned so it does not apply as prior art and hence there is no motivation to put the Het groups.

This is not found to be persuasive as US 6538005 Gutterer Beate ( cited in the IDS) does teach a similar core see

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and R6 can be a het. ring such as a morpholine piperidine ,  
pyrrolidine.

So the prior art does teach het ring s at that position. The core is very similar and the prior art teaches having different het groups. The use is the same. When the use is the same and the core and substituents are so similar small modification within the same markush substituents would be obvious to one of skill in the art of drug design such as the applicants to make such modification and expect the properties to remain the same. In the absence of unexpected results the claims are obvious over those of the prior art. Applicants arguments cannot replace evidence of unexpected results.

The rejection is modified and now maintained over the new claims 18-21.

The rejection of the old claims 1-17 under ODP has been withdrawn, however a new ODP rejection over the new claim 18-25 is now given for similar reasons as given in the 103 rejection above. The prior patents WO 99/05111, WO, 02/05616, WO 2004/019945 and US 6538005 Gutterer Beate all disclose compounds of a similar core and also similar substituents for the same use. As explain in the previous rejection applicants have not shown any unexpected results

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of the co-pending applications and patents. In the absence of this the rejection is made over

US 7,329,676

US 6,121,279

US 6,127,378

US 6,191,138

US 6,410,551

US 6,476,025

US 6,306,869

USSN 11/884,934

USSN 11/590,803

USSN 10/591,472

USSN 11/795,981

USSN 10/524,820 (now US 7,329,676, cited above)

USSN 11/885,423

### *Claim Objections*

Claims 18-21 are objected to because of the following informalities: The claims contain a Markush group with a formula. The difference substituents are not defined. Some species are given and one can tell what the R groups are, however it is confusing as the definitions are not defined or in other words the antecedent basis of the R groups is not clear. Appropriate correction is required. (Applicants can just delete the formula I).

The R4 and OR41 is the same as all the R4 are -OH groups.

***Conclusion***

Claims 18-25 stand rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/  
Primary Examiner, Art Unit 1625

March 22, 2010 .